

**REMARKS**

Claim 1 has been amended to respond to the rejection based on asserted new matter and for clarification. Support for this amendment is found in paragraph 15, line 3, and in paragraph 14, line 3. Further, this amendment clarifies that the “mechanical techniques” are applied to the tissue itself.

It is understood from the discussion at the interview that the claim as presently proposed to be amended does not constitute new matter in view of the cited support in the specification. However, it became clear that the claims as previously proposed which included claim 3 requiring the separation of cells by surgical procedures were not interpreted as applicants intended. It is noted that claim 3 was included in the rejection set forth in the Office Action mailed 23 January 2006 over Hadjantonakis, even though Hadjantonakis disclosed only separation by flow cytometry. This cannot be considered a surgical technique, and applicants believe that surgery must be interpreted as manipulating tissue, not individual cells that have already been separated.

Unfortunately, in attempting to clarify this distinction, the response filed by applicants on 26 May 2006 did not amend the claims in such a manner as supported *in haec verba* in the specification. Applicants believed that in light of the previous existence of claim 3, the rewording of claim 1 did not introduce new matter. Applicants assumed that although the application did not specifically state that the separating step was from a location in the tissue, that this was inherent in the term “surgical”.

Nevertheless, applicants are willing to reword the claim to set forth the invention in a manner now recognized by the Office as clearly supported by the specification. Applicants’ view of

this is further supported by the fact that claim 3 was canceled in the response filed on 26 May 2006 as redundant (although this was not specifically stated as the reason in the Remarks).

No new matter has been added and entry of the amendment though made after final, is respectfully requested as it responds directly to the new grounds for rejection set forth in the Office action. In addition, consideration had already been given to the use of surgical procedures by virtue of the inclusion of now canceled claim 3 in the original examination.

Applicants appreciate the withdrawal of a number of rejections previously made. The following discussion addresses the new grounds of rejection/objection.

#### Claim Objections

The Office objects to the asserted redundancy of the last line of claim 1 with the recitation in line 4 (sic, 2). Respectfully, applicants do not believe this is redundancy, but simply describes the result that is obtained. It is believed that a description of the cells as “separate” is different from the characterization of the method as involving “separating.” Applicants prefer to leave this phrase in the claim. As it is not a basis for rejection, and applicants are entitled to claim their invention as they see fit within the requirements of the statute, respectfully, it is believed that applicants may, if they choose, retain this phrase.

Applicants believe that agreement was reached at the interview that this phrase could remain.

#### The Rejection Under 35 U.S.C. § 112, First Paragraph

The rejection is based on “new matter,” objecting to the phrase “from a location in the tissue,” which does not appear *in haec verba* in the specification. Applicants have reworded the

claims in response to this rejection, and this phrase no longer appears. Support for the present wording has been set forth above and applicants believe that the amendment should be entered, though made after final, since this is a new basis for rejection and they have had no opportunity previously to respond.

In light of the amendment, it is believed this rejection may be withdrawn, and applicants appreciate the recognition that the proposed language for claim 1 is supported by the specification.

#### The Rejection Under 35 U.S.C. § 103

All claims were rejected as assertedly unpatentable over Hadjantonakis in view of Rashidi, *et al.*, and Trumper, *et al.*

The claims now require separating the labeled cells “mechanically” from the surrounding tissue, *i.e.* the separation is “surgical” as in former claim 3. The Office kindly agrees that this distinguishes the invention as now claimed from the primary document, Hadjantonakis, which describes only cell sorting by flow techniques.

Rashidi is cited as remedying a deficiency in Hadjantonakis with respect to claim 2 and claims dependent thereon which require that the cells be tumor cells. Applicants agree, assuming *arguendo* that there is motivation to combine these documents, that Rashidi remedies this deficiency.

The other secondary document, Trumper, is said to remedy the deficiency that Hadjantonakis fails to disclose mechanical separation from the surrounding tissue. This deficiency must be remedied in order to validly reject all of the claims, as all of the claims require this method.

Respectfully, applicants do not believe that Trumper, *et al.*, teach mechanical (or surgical as in canceled claim 3) separation of one or more desired cells from surrounding tissue based on cell surface staining and/or cell morphology. A careful reading of Trumper shows, as the Office itself states, that single-cell suspensions are prepared from fresh tissue and then individual cells are identified using a phase-contrast microscope after being plated on a surface. This, in applicants' definition, is not a mechanical separation from surrounding tissue or a surgical technique. Surgery involves manipulation of actual tissues, not picking individual cells from a surface on which they individually are plated, and thus already separated from surrounding tissue. The cells in Trumper are already separated from surrounding tissue when they are removed from the surface.

Accordingly, Trumper does not suggest the technique that is used to separate the fluorescent cells as required by the claims and fails to overcome the deficiency in the primary document. For this reason, it is respectfully submitted that the combination of Hadjantonakis with Trumper does not defeat the patentability of claim 1, even if motivation to combine these documents were to be found.

For this reason, applicants believe this basis for rejection may be withdrawn.

### Conclusion

The claims have been amended to overcome the newly articulated rejection under 35 U.S.C. § 112, paragraph one. The combination of documents cited by the Office does not render the claims obvious because the documents, even in combination, fail to disclose mechanically separating one or more living cell [of any kind] from surrounding tissue." Accordingly, applicants

believe that claims 1-2 and 5-11 are in a position for allowance and passage of these claims to issue is respectfully requested.

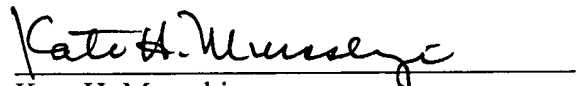
Examiners Sang and Helms are again thanked for their consideration of the undersigned at the interview. If outstanding questions remain that could be resolved over the telephone, a call to the undersigned would be appreciated.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 312762004100.

Respectfully submitted,

Dated: August 17, 2006

By:



Kate H. Murashige  
Registration No. 29,959  
MORRISON & FOERSTER LLP  
12531 High Bluff Drive  
Suite 100  
San Diego, California 92130-2040  
Telephone: (858) 720-5112  
Facsimile: (858) 720-5125